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David K. Lee

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EXAMINER

NELSON, FREDA ANN

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,292	<b>Applicant(s)</b> LEE ET AL.	
	<b>Examiner</b> FREDA NELSON	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

In view of the Appeal Brief filed on October 15, 2008, PROSECUTION IS  
HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the  
following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply  
under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed  
by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and  
appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth  
in 37 CFR 41.20 have been increased since they were previously paid, then appellant  
must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by  
signing below:

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628

### **DETAILED ACTION**

The Appeal Brief received and amendment received on October 15, 2008 is acknowledged and entered. Claims 11-21 and 25-29 have been canceled. No claims have been added. Claims 1-10 and 22-24 are currently pending.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-10 and 22-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result.

Claims 1-10 and 22-24 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the

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apparatus that accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-10 and 22-24 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-10 and 23-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer (US PG Pub. 2002/0046194), in view of Bennett et al. (US Patent Number 7,117,170), still in further view of Wilz, Sr. et al. (US Patent Number 6,510,997).

**As per claims 1 and 10**, Gelfer discloses a method for tracking a special service delivery by a carrier of a mail item created by an office worker, the method comprising the steps of: applying a special service indicator, (identity certificate), to the mail item during creation of the mail item (paragraph [0004]), identity certificate; see FIG. 1);

sending the mail item to a mail room, (data center), for final processing prior to submitting the mail item to the carrier for the special service delivery, (paragraph [0004], identity certificate can be used by the carrier for delivering in the data center);

automatically detecting at the mail room the special service indicator on the mail item and determining the special service delivery required based on the detection of the special service indicator (paragraph [0004], the information contained in the identity certificate can be used by the carrier for delivering and billing in the data center); and

submitting the mail item with the unique identifier thereon to the carrier for the special service delivery (paragraph [0004], the information contained in the identity certificate can be used by the carrier for delivering).

Gelfer does not explicitly disclose applying at the mail room a unique office worker generated identifier to the mail item; and providing the office worker with access to the company server to obtain the information relating to the location of the mail item.

However, Bennett et al. discloses the System assigns the package a System package tracking number and adds a record containing all of the pertinent information about the package to the System database 22 (col. 53, lines 5-39; FIG. 58). Bennett et al. further disclose FIG. 69 is a logic flow diagram that depicts the high level logic for tracking the status of a particular package. The User enters 2018a and 2018b a tracking number 19 in the tracking number field 2035 (as was shown in FIG. 68). The System first validates 2050 the tracking number 19 and the System performs the validation process by attempting to access the record on the System database 22 that is associated with the tracking number 19. To do this, the System requests that a System database server, e.g., 20a (as depicted in FIG. 5) locate and retrieve the package record that is associated with the tracking number 19. The System database server,

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e.g., 20a as depicted in, e.g., FIG. 5, uses the entered tracking number 19 to search the System database 22 to locate and retrieve the specified package record.

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify the invention of Gelfer to include the features of Bennett et al. to emulate an invention that deals with the billing and tracking of mail by using labels and bar codes as an indicator, in order to make an invention more efficient.

Bennett et al. does not disclose that the unique identifier includes an electronic address of a company server; and receiving from the carrier at the electronic address obtained by the carrier from the unique identifier on the mail item information relating to the location of the mail item.

However, Wilz, Sr. et al. discloses in FIG. 9, each Package Log-In/Shipping Subsystem 52 is realized as either a desktop or portable Internet Access Terminal of the present invention shown in FIGS. 1, 2, or 3 and described above. The function of the Package Log-In/Shipping Subsystem 52 is to log-in each package with a relational database management system (RDBMS) maintained within or behind the RTD Internet Server 51 of the system. As will be described in greater detail hereinafter, this log-in procedure involves: (1) accessing a RTD Internet Server 51 by reading a particular predesignated URL-encoded bar code symbol specifying its address on the Internet; (2) entering package-related information into the system by way of the Internet; (3) creating and printing a custom bar code symbol label encoded with the URL (and Zip-Code) and an address label bearing the name and address of the entity to whom the package is to

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be delivered; and (4) applying the bar code label and address to the package prior to shipping for carrying out routing, tracking and delivery functions (FIGS. 9 and 13-15).

Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention was made to modify the mail tracking invention of Gelfer to include the bar-code encoded with URLs feature al. of Wilz, Sr. et al. in order to provide more accurate tracking since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**As per claim 5**, Gelfer discloses a method wherein the special service indicator is a label (paragraph [0011] identity codes are printed in the form of bar-codes on self adhesive labels which can removed).

**As per claim 6**, Gelfer discloses a method wherein the special service indicator is printed on the mail item (paragraph [0011], identity codes are printed in the form of bar-codes on self adhesive labels which can removed).

**As per claim 7**, Gelfer discloses a method wherein the special service indicator is machine readable (paragraph [0009], readers can be provided at one or more delivery stations for reading the identity codes).



**As per claim 8**, Gelfer does not explicitly disclose a method as recited wherein the information relating to the mail item includes an image of the mail item.

However, Bennett et al. discloses FIG. 55 depicts a flow diagram of an exemplary embodiment of the aspect of the invention that provides printing of dimensionally accurate images, such as dimensionally sensitive symbologies including two-dimensional bar codes and other two-dimensional machine readable symbologies. This aspect of the invention provides the printing of such dimensionally accurate images on various types of printer devices including among others HP-compatible laser printers. The printer devices can be configured with remote computers, such as PC's, that will receive signals to print the dimensionally accurate image over a communications network such as the Internet. Each PC having a client browser or executing like software, and each PC being configured with a pre-established Image Resolution that applies to the display device and the printer device configured with the PC (col. 48, lines 43-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made modify the invention of Gelfer with the features of Bennett et al. in order to generate an image of the mail item to be delivered providing the image is stored in the database for later usage as taught by Bennett et al. with the motivation of providing an image to an client.

**As per claim 9**, Gelfer discloses a method wherein the information relating to the location of the mail item further includes date, time, and location data, ([0009], allowing

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monitoring of the exact route of the mail piece. Used for tracking and tracing). This suggests that the location of the mail piece can always be tracked. Also on ([0009], that a storage memory can be used to store information about the mail pieces).

**As per claim 22**, Gelfer discloses a method as recited in claim 1, wherein the mail item is in a receptacle containing other mail items (paragraphs [0016],[0020]; FIG.1).

**As per claim 23**, Gelfer discloses a method as recited in claim 22, wherein the location of the receptacle is determined (paragraph [0020]).

**As per claim 24**, Gelfer discloses a method as recited in claim 23, wherein the location of the mail item is determined by knowing the location of the receptacle (paragraphs [0018]-[0020]).

3. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelfer (US PG Pub. 2002/0046194), in view of Bennett et al. (US Patent Number 7,117,170), still in further view of Wilz, Sr. et al. (US Patent Number 6,510,997) as applied to claim 1 above, and further in view of Bloom (US Patent Number 6,974,928).

**As per claims 2-3**, Gelfer does not explicitly mention a method wherein the special service indicator is a specific color associated with the special service delivery;

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and the specific color is automatically detected and identified to determine the special service delivery required by the mail item.

However, Bloom discloses cases of temperature-controlled items can, for example, be labeled with a different color label or marked in some way to indicate that they contain temperature-controlled items. RDC workers performing the local market sort and the CDC sort can give a higher priority to cases of temperature-controlled items to move them through the RDC faster; and items can be picked from cases containing temperature-controlled items to create temperature-controlled bulk delivered packages. Temperature-controlled bulk delivered packages can be added to temperature-controlled delivery shipments and can be shipped to CDC's or LDDH's on temperature-controlled vehicles (col. 142, lines 5-17).

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to modify the invention of Gelfer in view of Bennett et al. and Wilz, Sr. et al. to include the special label color feature of Bloom in order to provide the users an indicator that is color correlated with motivation of having a system that is able to associate a color indicator with a particular delivery service or priority since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

**As per claim 4**, Gelfer does not disclose a method as recited in claim 3, wherein the specific color is selected from a plurality of different colors, each of the plurality of different colors serving as an indicator of a different special service delivery requirement.

Bloom discloses although cases of standard-temperature items and cases of temperature-controlled items can be mixed together, RDC workers performing the local market sort and CDC sort can, for example, recognize cases of temperature-controlled items by a different color or marking on their case label and can move them through the RDC with a higher priority. Bloom does not explicitly disclose a plurality of different colors, however, *“workers performing the local market sort and CDC sort can, for example, recognize cases of temperature-controlled items by a different color or marking” suggests that there are others colors users for packages that are not-temperature-controlled.*

Therefore, it would have been obvious to a person of ordinary skill in the art the time the invention was made to modify the invention of Gelfer in view of Bennett et al. and Wilz, Sr. et al. to include the special label color feature of Bloom in order to provide the users an indicator that is color correlated with motivation of having a system that is able to associate a color indicator with a particular delivery service or priority since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

1) Wilz, Sr. et al. (US Patent Number 6,394,354), which discloses Internet-based system and method for routing, tracking and delivering packages using URL-encoded bar code symbols

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday, from 10:00 am-6:00 pm .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. N./

Examiner, Art Unit 3628

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628